

Application Number 10/722,628
Amendment Dated August 7, 2006
Reply to Office action of June 8, 2006

REMARKS/ARGUMENTS

The Examiner has rejected claims 1-2 and 8-12 under 35 USC 103(a) as unpatentable over Moen '121 in view of Nambu or Takano et al.

This rejection is traversed.

Nambu teaches use of PTFE in an Exhauster Pressure Control System for use in a gaseous environment because of its non corrosiveness, not lubricity.

Takano et al deals with a pressure equilibrator for gases as well. His slider 20 is disclosed to be required to minimize resistance against movement by making it out of lightweight material such as aluminum or Teflon or Derlin.

Moen '121 as previously argued, discloses an entirely metal cycle valve, which is expensive due to use of all metal (admitted by Examiner) in fabrication thereof.

Applicant is not looking for non corrosiveness, or lightweight but rather economy of manufacture, not disclosed anywhere in the proposed combination,

Here see: Uniroyal, Inc., v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988):

(2) "When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason

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for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination."

In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989):

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985):

"The trial court committed a "fundamental error" by characterizing the patent in suit as a "combination patent comprised exclusively of old elements." Nothing in the prior art as a whole suggested the combination to one of ordinary skill in the art."

In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) (in banc):

"The PTO is obligated to consider all the evidence of the properties of the claimed invention as whole, compared with those

of the prior art."

With respect to the seals disclosed by Moen '121, applicant's seals are not shown in Figure 2 of Moen '121, which as shown in applicant's Figure 1 would engage 55 and 57 of Fig 2 of Moen '121 and seat over 54 and 56 of Fig. 2 of Moen '121.

If such area of Moen's Figure 2 is not sealed, with the structure of their Figure 2 actually made of PTFE, leakage would result, as well as a decreased of longevity of the cycle valve.

Here see: Uniroyal, Inc., v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988):

(4) "A proper combination of references requires the presence of a teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one of ordinary skill in the art to make the combination. The mere fact that a device or process utilizes a known scientific principle does not alone make that device or process obvious."

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988):

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984):

"The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness

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rejection unless the prior art suggested the desirability of such a modification."

Thus, there can be no obviousness and the rejection is believed to be traversed.

Claims 3-4 are next rejected under 35 USC 103(a) as unpatentable over Moen '121 in view of Powers et al.

Inapplicability of Moen's structure has already been argued above. The remainder of the rejection is not understood.

Powers et al 1923 patent discloses a pressure equalizing shower mixer having a biasing spring, apparently to prevent scalding.

One is hard pressed to figure out how to place a spring between Moen spool(sic) valve member 40 and stem 44, since they appear immovable relative to each other.

Still further, reference to a further Moen patent 4,305,419 is not understood. Is it being cited against the Claims, or not?

Even if cited, it would not change the illogical reasoning in this rejection .

Here see: Interconnect Planning Corp., v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985):

"It is error to reconstruct the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must

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be some reason for the combination other than the hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination."

Uniroyal, Inc., v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988):

"(1) The district court erred in finding the patent claiming an air deflecting device for reducing wind resistance encountered by tractor-trailer combination vehicles invalid for obviousness by

(a) impermissibly us[ing] hindsight to reconstruct the claimed invention from prior art with the [patented] invention before it and aided by [the accused infringer's] expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made, and

(b) erroneously analyz[ing] and weigh[ing] secondary considerations of nonobviousness."

Accordingly it is believed this rejection it traversed.

Next, claims 5-7 and 12-13 are rejected under 35 USC 103(a) based on a combination of all of the above cited references.

Applicant reiterates all arguments above here and again finds no basis for the rejection having a solid evidentiary base since there is no motivation found anywhere in any art to create applicant's structure.

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Here see: Diversitech Corp., v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988):

(3) "The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem."

Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103."

Finally, not a single piece of prior art mentions, let alone suggests an embodiment of decreased manufacturing cost, which applicant's embodiment accomplishes.

Here see: Solder Removal Company, et al. v. United States International Trade Commission, et al., 582 F.2d 628, 199 USPQ 129 (CCPA 1978):

"The ALJ appears to have viewed arguments that an invention solved a problem not previously recognized, and that nonobviousness may be evidenced by discovery of a problem source, as irrelevant. That view would be incorrect. In re Sponnoble 56 CCPA 823, 832-33, 405F.2d 578, 585, 160 USPQ 237, 243 (1969); In re Linnert, 50 CCPA 753, 758, 309 F.2d 498, 502, 135 USPQ 307, 310 (1962); In re Antonson, 47 CCPA 740, 741-42, 272 F.2d 948,

949, 124 USPQ 132, 133 (1959). The ALJ appears also to have felt that where a practice is suggested by the prior art to solve one problem, a conclusion of nonobviousness cannot be supported on the ground that it also solves another problem, previously recognized or not. That position would be too broad. Where that reason for the practice suggested by the prior art is much less significant than the reason derived from the inventor's solution to another problem, the results may be so unexpected as to support a conclusion of nonobviousness.

White v. Tak-Trak, Inc., et al., 1963 WL 8092 140 USPQ 156
(DC SCalif 1963):

(2) "Fact that patented invention did not produce an entirely new or startling and unheard-of result does not negative invention since it is not essential that result be wholly new, it being sufficient if old result is effected in a more facile, economical, or efficient way, and results in inventive advance over prior art."

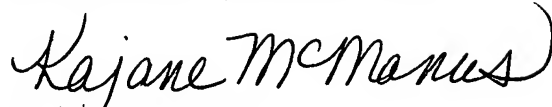
The case law citations applicable herein are voluminous, and applicant has selected only a few exemplary citations to incorporate herein for the sake of brevity. However, the citations well support applicant's position that the claims are allowable over the cited art.

An earnest endeavor has been made to prove allowability and

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an action to that end is awaited.

Respectfully submitted,

A handwritten signature in cursive script that reads "Kajane McManus". The signature is written in dark ink and is positioned above the printed name and registration number.

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U.S. Patent

Sep. 4, 1984

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4,469,121

40 = inner casing
 spool et piece

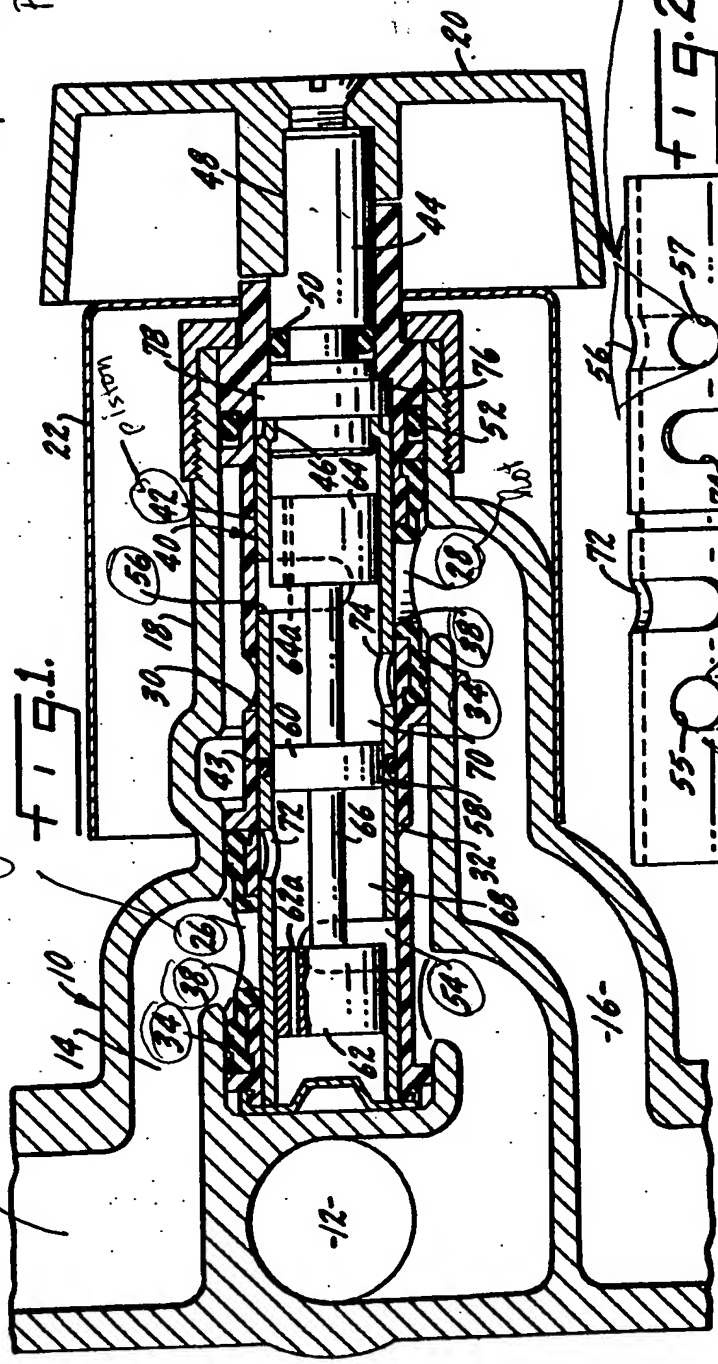
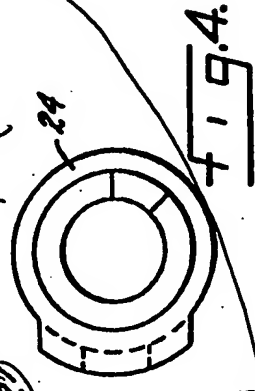
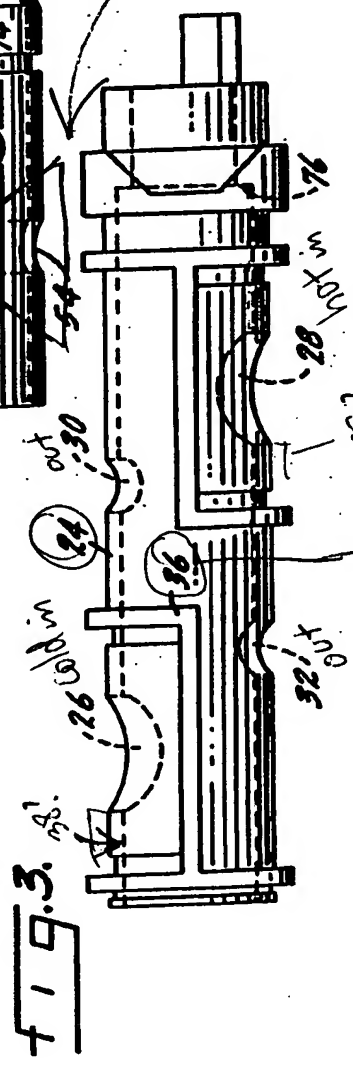


FIG. 2
 K piston



OUR INSERTS



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 sleeve
 MOEN

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